REMARKS

Overview

Claims 1, 3-16, 18-57, 59-74, and 76-89 are pending in the present application. Several claims have been indicated to be allowable if appropriately rewritten.

The present response is an earnest attempt to advance prosecution of the present application. It is filed concurrently with an RCE towards that end. Reconsideration is respectfully requested.

35 U.S.C. § 103 Rejections

The sole issue in the application is whether the claims are obvious under § 103. Applicants respectfully submit the claims are not obvious and wish to point out the following.

It is respectfully submitted Applicant's claims are patentable because they are novel and non-obvious because, inter-alia, the cited references teach away from Applicant's claims.

A *prima facie* case of obviousness under § 103 requires that the references teach in an enabling fashion reason, suggestion, or motivation to combine or modify them in a manner which appears to show or suggest the claimed invention to one of ordinary skill in the art. The recent *KSR International* case confirmed that the analysis should be conducted using the *Graham v Deere* legal framework. *KSR* also cited *United States v. Adams*, 383 U.S. 39 (1966) for the proposition that references that teach away from the claimed combination are probative of non-obviousness.

Cited U. S. Patent No. 6,340,790, is one example of the state of the art. It is commonly owned by the owner of the instant application. Figures 1-3 illustrate variations of several known substantially tall poles. Figures 6-8 illustrate features of the pole of the '790 patent. The pole of

the '790 patent is either a single or multiple section tapered hollow metal pole that can be slip fit to a concrete base anchored in the ground. Sections can be serially slip fit together to form a completed pole. The pole is load-bearing and structural, and metal. Importantly, it is galvanized (see U. S. Patent No. 6,340,790, col. 2, lines 44-46), as an added measure of protection against corrosion of such metal poles. The Gordin '790 patent therefore teaches one or more piece, tapered, hollow, metal, galvanized, load-bearing structural poles for elevation of items to substantial heights.

Secondary reference, Fox, U. S. Patent No. 4,019,301, suggests adding an encasement around a structural member such as a piling, to protect it from action of water. Fox teaches a "fiber glass, epoxy resin, or other inert, corrosion resistant material" (see Fox Abstract) used as a form for insertion of "a filler of concrete, epoxy resin or the like between the encasement sleeve and the piling." (Fox Abstract). Its background states other similar combinations existed for protecting pilings. Its advance is described as an improved sleeve made of a rigid body (Fox, col. 2, line 25), and a tongue and groove arrangement longitudinally to help hold the sleeve in a spaced apart arrangement from the underlying structural member to leave a space for the filler. The sleeve has to be formed with essentially the same "cross-sectional configuration as the structural member" but "is of larger size so that the outer surfaces of the enclosed structural member are spaced from the inner surfaces of the encasement member to define a continuous gap therebetween. The system also includes a filler of inert material, inside gap and filling the same, the filler bonding the encasement member to the structural member. The encasement member has a rigid body made of a chemically-inert, corrosion resistant material such as fiberglass. . ." (Fox, col. 2, lines 14-27). The system is described as not only encasing the piling but " also effective in reconstructing the structural integrity of the pilings or other members to which they

are applied." (Fox, col. 1, lines 19-22). As pointed out, Fox therefore teaches a rigid outer encasement form that has to be premolded in the cross-sectional shape of the underlying structural member and in a manner leaving a gap to receive a filler that bonds the outer encasement to the structural piling to form a sealed off encasement. Fox alleges its system is an improvement over prior fiberglass sleeves with inert bonding filler to encase a piling.

U. S. Patent No. 3,968,561 to Oakes takes a quite different concept. As made clear by its title, "Method of Fabricating Hollow, Foam-Filled, Metal Structural Members", it teaches use of a metal hollow "structural member" (Oakes Abstract). A foaming mixture is then introduced into the hollow interior of the metal outer member. The foaming mixture hardens to a final rigid foam of relatively high density (Oakes, col. 2, lines 54-55). The foam acts as "an extremely strong adhesive and in addition forms a continuous fluid-tight seal along each joint that will prevent or restrict penetration of water or moisture into the interior of the complete structure." Oakes, col. 3, lines 1-6. One example of implementation is as a window encasement. Oakes alleges an improvement over prior foam-in-outer-metal-hollow-casing combinations. The completed product of Oakes is the result of first forming the outer metal member and then introducing the foaming material for mixture therein, and letting the foaming mixture form into a rigid bonded material with and inside the outer metal sleeve.

Swanson, U. S. Patent No. 4,092,079 is a very specific system for repairing existing utility poles. Sleeve 38 is installed between a top and bottom pole section and must structurally support those sections at that joint. Sleeve 38 must therefore be very strong and rigid to hold up, for example, a heavy wood top of many feet in length. It is cylindrical and includes holes through which fasteners can be cast to lock the pole sections to the sleeve. The sleeve extends

for relatively small distances on opposite sides of the joint between upper and lower pole sections.

In contrast, Applicant's independent claims 1, 42, 54, 56 and 73 describes a combination of covering substantially tall pole with a thin sheet of plastic material. As stated in Applicant's Specification, such a covering can have several functions. None are load-bearing or structural in nature. Not only can it serve to further protect the surface of the pole, it can change the surface of the pole (for appearance, texture, or other purposes).

Gordin '790 patent has no disclosure or teaching of adding anything to the exterior of its pole other than galvanization.

Oakes has no disclosure or teaching of adding anything to the exterior of its outer metal structural member.

Swanson has no disclosure or teaching of adding anything to substantially all of the exterior of its pole sections. It is limited to a structural joint.

Fox does disclose and teach a system for encasing a structural member. However, it uses an old combination of an outer formed piece filled with filler material. It does so in the context of trying to further protect a piling that has a portion under water.

Therefore, Gordin '790 teaches away from the present invention. Fox does likewise. Swanson does likewise in its complete absence of disclosing or teaching any added covering to a pole. Oakes does likewise in its absence of any teaching or suggestion of adding a further covering over its outer metal form.

Applicant's claims do not include some sort of filler between its cover and the structural member. As described in Applicant's specification, wind load is a significant issue on relatively tall poles. Wind load, as well as structural load, pertains to the mass and size of the pole.

Adding an outer encasement with a gap, and filling the gap with concrete or the like, is not indicated when Gordin '790 teaches galvanizing a metal pole is sufficient. It would add weight and wind load to the pole.

One of ordinary skill in the art would not look to Swanson for the solution of the claimed invention. There is no aspect of repair or modifying structural support of the pole in the claimed invention.

Likewise one of ordinary skill in the art would not look to Oakes for any assistance in coming to the claimed invention. Oakes actually teaches the reverse of the present invention. It forms an outer sleeve and then introduces the foam mixture inside the sleeve that must cure into the high density structural member.

For at least these reasons, it is respectfully submitted a *prima facie* case of obviousness is not shown by any of the combination of references in the Office Action.

To attempt to advance prosecution, revisions have been made to the independent claims which will be discussed below.

Claim 1 has been revised to add some of the concepts from the objected-to claims from the final rejection. Specifically, the underlying structural pole is defined to be tapered. The covering layer is defined to be trapezoidal in flat orientation such that it can be wrapped around the pole. A fastener is used to fix or secure the wrapped sheet on the pole. Gordin '790 has no teaching of any exterior covering. Fox teaches a rigid outer encasement that must be premolded in shape to the cross-section of the inner piling. There is no teaching of a trapezoidal flat projection of the casement. Swanson requires a rigid structural cylinder. Oakes requires a premolded or formed cross-sectional shape that is not wrapped. It is therefore respectfully

submitted independent claim 1 and its depending claims are allowable over any of the combinations of references in the Office Action.

Independent claim 42 is a method claim. 35 U.S.C. §§ 100 and 101, provide additional grounds for allowance of method claim 42 and its depending claims. No single cited reference or combination of references discloses the combination of method steps in independent method claim 42. Even if for arguments purposes, the concept of a covering over a pole is considered to be old apparatus, specific methodology of covering and conforming in a non-load bearing relationship a sleeve or plastic material is not taught or obvious in light of the cited references. It is respectfully submitted claim 42 and its depending claims are allowable over any of the rejections based on obviousness.

Independent claim 54 addresses another aspect of the Applicant's invention. It specifically defines the cover as "a plurality of independent members arranged along the pole". This allows smaller pieces to be used to cover larger sections of the pole. Gordin '790 has no additional cover over the pole. Oakes has no additional member over its outer metal shell 10. Swanson has no additional member over its structural joint or its upper or lower pole sections. Fox describes encasement member 10 "may be made of any suitable length and, if desired, may be cut to the same length as the pile which is to be covered. It may also be made appreciably shorter than the pile and be located in the title region of the water line where the pile is subject to most aware." Fox, col. 4, lines 9-14. It does not describe two or more sleeve sections, one after another, along the structural member. It is therefore respectfully submitted independent claim 54 and 55 are allowable over any of the cited references or rejections in the action.

Independent claim 56 specifically describes a substantially tall hollow metal pole of one or more tapered sections used to elevate at least one high intensity lighting fixture. It specifies

the layer is comprised of "a flexible plastic, fraction of an inch think sheet material adapted to be positioned in conforming relationship around the exterior of the pole, the layer being formed into a truncated cone substantially matching the taper of the pole" Claim 56 additionally has limitations regarding opposite edges are adjacent or overlapping when the sheet is conformed around the pole. Gordin '790 does not teach a flexible plastic thin sheet over the pole. Oakes does not teach the same -- it teaches a pre-formed sheet metal exterior. Swanson teaches a highly structurally robust joint in cylindrical form. Fox teaches a pre-formed fiberglass, epoxy resin or other inert corrosion resistant potentially rigid material. It is therefore respectfully submitted independent claim 56 and its depending claims are allowable over any of the cited references or rejections.

Independent claim 73 describes "a single non-load bearing covering layer of flexible plastic" wrapped or placed around a pole. Gordin '790 has no additional covering layer. Oakes does not teach a plastic unload bearing layer. Swanson does not teach a plastic flexible non-load bearing layer. Fox does not teach a plastic, flexible, single non-load bearing layer. It is therefore respectfully submitted independent claim 73 and its depending claims are allowable over the references and any of the § 103 rejections.

The Office Action alleges that "Fox teaches the benefits of the plastic sheet as protection against the elements and the Office Action is not combining the slurry with Gordin." Office Action, page 9, first partial paragraph. However, it is respectfully submitted that a *prima facie* case of obviousness must establish an apparent reason to combine references in a fashion claimed. As pointed out above, the concept of encasing an under-water piling in an outer forming sleeve with an inner filling has long been known. The present invention does not claim or cover that combination. There is no need or desire to add filler material of structural mixture

through the outer exterior of a pole. Fox therefore teaches away from the claimed invention and thus does not support a *prima facie* case of obviousness of the present invention. The fact that Fox was issued in 1977 (filed in 1973), and refers to earlier encasement methods for pilings which use an outer form and an inner filler, corroborates the non-obviousness of the claimed invention.

Conclusion

It is respectfully submitted that all matters raised in the latest Action have been addressed and remedied and that the application is in form for allowance. Favorable action is respectfully requested.

This Amendment accompanies a Request for Continued Examination (RCE). Please charge Deposit Account No. 26-0084 the amount of $810.00 per the attached Transmittal. No other fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

This is a request under the provision of 37 CFR § 1.136(a) to extend the period for filing a response in the above-identified application for two months from January 15, 2008 to March 15, 2008. Applicant is a large entity; therefore, please charge Deposit Account number 26-0084 in the amount of $460.00 to cover the cost of the two-month extension. Any deficiency or overpayment should be charged or credited to Deposit Account 26-0084.

Reconsideration and passage to issuance is respectfully requested.

Respectfully submitted,

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